

REMARKS

Review and reconsideration on the merits are requested.

Applicants appreciate the Examiner reopening prosecution on the merits and accepting the Terminal Disclaimer.

Applicants now turn to the balance of the Action, noting that the limit “40:” has been added to claim 7, this is still an (original) claim since “40:” was simply omitted in the last AMENDMENT.

The prior art:

US 5,607,687 Bezwada et al (Bezwada); US 4,541,426 Webster (Webster).

The rejections: claims 1-9 are rejected as anticipated/obvious over Bezwada. Paragraph 5 of the Action.

Claims 17 and 18 are rejected as obvious over Bezwada in view of Webster. Paragraph 6 of the Action.

The Examiner’s position is set forth in detail in the Action and will not be repeated here except as necessary to an understanding of Applicants’ traversal which is now presented.

First, Applicants limit the claims by the use of “consisting essentially of” language.

Next, they included into the claims the limitation fairly supported in the specification at page 6, third full paragraph in view of the paragraph bridging pages 13/14.

Thus, the single layer substrate film with the present invention is now limited to the recited components and excludes the presence of components would alter the basic and novel

characteristics of the single layer substrate or the adhesive sheet, when read in light of the newly added language to the end of claim 1 (which is included into claim 17).

It is submitted that Bezwada in no fashion suggests the subject matter of the claims as now limited, especially considering that the recitation “for an adhesive sheet” in the preamble (see Action, page 5, first full paragraph) should now be attached patentable weight. Applicants later return to this point.

The Invention

The present invention relates to an adhesive sheet which consists of a substrate film and an adhesive layer (claims 17, 18) and a substrate film which is uniquely adapted to be used with such an adhesive sheet (claims 1 to 9).

The essence of the present invention resides in the composition of the substrate film recited in claims 1 to 9 which is characterized by comprising an elastomer resin and a hydrophilic polymer having a higher modulus strength than the elastomer resin. To clarify this essence or gist of the invention, Applicants amend claim 1 by using “consisting essentially of” language. In this regard, it is appropriate to see exactly what Bezwada teaches.

Bezwada

Bezwada discloses polymer blends comprising a polyoxaester as a main component. The Bezwada blend has a specific composition and shows bioabsorbable properties. Bezwada discloses materials which may be used for surgical operations such as a suture and medical materials. Thus, even though Bezwada and the present invention both involve the use of a

SECOND AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No.: 10/028,914

polymer, the technical field and objects in Bezwada are quite dissimilar from those of the present invention.

As the Examiner will appreciate, the adhesive sheet of the present invention is not bioabsorbable. A bioabsorbable adhesive sheet would, in a short period of time, turn out to be useless for purposed of the present invention.

Applicants respectfully request a **telephone interview** if the Examiner is not convinced of the patentability of the claims as currently amended since they do believe that this basic difference between the present invention and Bezwada is so central to the two inventions that one of ordinary skill in the art, reading Bezwada, would not be motivated to reach the present invention.

With respect to the Examiner's position on inherency, specifically with reference to claims 1-4, 6 and 8 in the Action, Applicants would agree with the Examiner that if a claimed product and a prior art product are shown to be identical or substantially identical in structure or composition, etc., a *prima face* case of anticipation or obviousness has been established. However, the present instance Applicants respectfully submit that the products claimed herein and the Bezwada products are not identical or substantially identical in structure or composition. The Bezwada products are bioabsorbable and this apparently is due to the critical presence of the aliphatic polyoxaesters of Bezwada. Applicants respectfully submit that the "consisting essentially of" of the present claims would exclude substantial proportions of the aliphatic polyoxaesters as in Bezwada which are needed to make the Bezwada product bioabsorbable.

SECOND AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No.: 10/028,914

With respect to claims 5 and 7, specifically the Examiner's position regarding a suitable weight ratio between the hydrophilic polymer and the elastomer resin, Applicants respectfully submit the Examiner to be in error at this point. If the products of the present invention were bioabsorbable, contrary to the essence of the present invention, then there might be some validity to the Examiner's position. However, the products of the present invention **are not bioabsorbable**, and thus quite clearly the products claimed and the Bezwada products cannot be identical or substantially identical in structure or composition, etc. Certainly, there would be no reason for one to select a weight ratio to achieve the results of the present invention as set forth in claim 1 from the teaching of Bezwada.

With respect to claim 9, Applicants respectfully submit that given the basic difference in use between the present invention and Bezwada that the inventions are not for the same application as urged by the Examiner, i.e., bioabsorbable versus non-bioabsorbable, and respectfully submit that quite clearly claim 9 is patentable over the prior art.

Turning finally to the first full paragraph on page 5 of the Action, Applicants believe that they have now correlated "for an adhesive sheet" in the preamble with the portion of the claim following the preamble, and thus the language now used in the preamble should be attached patentable weight.

For all of the above reasons, withdrawal of the rejection over Bezwada alone is requested.

Applicants now address the rejection of claims 17 and 18 as being obvious over Bezwada in view of Webster.

Bezwada has been discussed above.

SECOND AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No.: 10/028,914


Applicants respectfully submit that what is lacking is motivation to combine Bezwada and Webster.

Webster discloses a dressing comprising a conformable aperture film. This has no relationship to an adhesive sheet in accordance with the present invention nor, in fact, is there any relationship between Webster and the bioabsorbable material of Bezwada. The Webster product is a laminated dressing which has a reduced tendency to adhere to skin lesions. In distinction, the tensile modulus of elasticity of the present invention is specified as being sufficient and comfortable for attachment over the skin, and this is now emphasized in claim 1. Since claim 17 includes the limits of claim 1, Applicants respectfully submit that claim 17 is patentable for the same reasons as advanced with respect to claim 1 and, for the further reason that there is no motivation for one of ordinary skill in the art to combine Bezwada and Webster.

Withdrawal of all rejections and allowance is requested.

A telephone interview is requested concerning this application; the Examiner is requested to contact the undersigned at the later given telephone exchange.

Respectfully submitted,


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